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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------------|
| 10/068,283 | 02/05/2002 | Axel Scherer | CIT.PAU.01 | 9733 |
| 7590 | 09/10/2004 | | EXAMINER | |
| Daniel L. Dawes MYERS, DAWES & ANDRAS LLP 19900 MacArthur Blvd, Ste 1150 Irvine, CA 92612 | | | | MCDONALD, RODNEY GLENN |
| | | ART UNIT | PAPER NUMBER | 1753 |

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | |
|------------------------------|--------------------|----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/068,283 | SCHERER ET AL. |
| | Examiner | Art Unit |
| | Rodney G. McDonald | 1753 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 June 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-15 is/are allowed.
- 6) Claim(s) 21-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 21-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 21-25 directionally etching an elastomeric material in combination with utilizing reactive sputter deposition to form a layer including silicon on an elastomer and forming subsequent masking layers thereon by means of which the three dimensional structure is photolithographically microfabricated in the elastomeric material is not discussed in Applicant's specification.

Allowable Subject Matter

Claims 1-15 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Claim 1 is indicated as being allowable over the prior art of record because the prior art of record does not teach the claimed subject matter including reactive sputter deposition of a layer including silicon thereon to allow for the formation of masking layers on the layer sputtered on the silicone elastomer by means of which the structure is photolithographically microfabricated.

Claims 2-15 are indicated as being allowable over the prior art of record because the prior art of record does not teach forming silicon dioxide, silicon nitride or silicon on an elastomeric material for decreasing the surface tension of the elastomeric material and photolithographically processing the elastomeric with the decreased surface tension.

Response to Arguments

Applicant's arguments filed June 24, 2004 have been fully considered but they are not persuasive.

In response to argument that support is present in Applicant's specification for directionally etching an elastomeric material in combination with utilizing reactive sputter deposition to form a layer including silicon on an elastomer and forming subsequent masking layers thereon by means of which the three dimensional structure is photolithographically microfabricated in the elastomeric material, it is argued that the specification of Applicant does not disclose the two procedures as combinable. Applicant's specification outlines steps for improving a method of microfabricating three dimensional structures in a deformable silicone elastomer and outlines steps for directional etching of an elastomeric material. There is no suggestion of combining the two processes as a single process. In fact Applicant's specification states that "In ***another plasma fabrication procedure***, we have developed a technique necessary to directionally etch elastomer material" which shows a delineation between the two procedures. Furthermore, claim 21 recites "directionally etching ***an*** elastomeric material" which does not refer back to the elastomer of claim 1. This is unclear because

it is uncertain if the microfabricating procedure is meant to incorporate the directional etch step or that the directional etch step is to be another procedure separate from the microfabricating procedure.

Conclusion

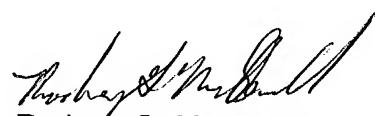
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney G. McDonald whose telephone number is 571-272-1340. The examiner can normally be reached on M- Th with Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X. Nguyen can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rodney G. McDonald
Primary Examiner
Art Unit 1753

RM
September 9, 2004